

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
1429.002

In Re Application Of Brockley et al.

Application No. 09/783,366	Filing Date 02/14/2001	Examiner Cassandra Davis	Customer No. 23405	Group Art Unit 3611	Confirmation No. 2305
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Title: SPORTS COMMEMORATOR FOR DISPLAYING A SPORTS RELATED OBJECT AND PICTURE

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

- * Appellants' Reply Brief to the Examiner's Second Answer (7 pages); and
- * Acknowledgement Postcard.

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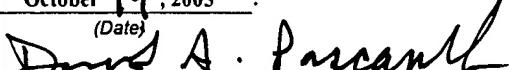
Dated: October 19, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Brockley et al. Attorney Docket No.: 1429.002
Serial No.: 09/783,366 Group Art Unit: 3611
Filed: February 14, 2001 Examiner: Davis, Cassandra
Title: SPORTS COMMEMORATOR FOR DISPLAYING A SPORTS RELATED OBJECT AND PICTURE

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APPELLANTS' REPLY BRIEF
TO THE EXAMINER'S SECOND ANSWER

Dear Sir:

In reply to the Examiner's Answer dated August 23, 2005, appellants submit this Reply Brief under new rules, 37 C.F.R. Part 41. The Reply Brief is due by October 23, 2005, without extension. Therefore, this Reply Brief is timely filed.

ARGUMENT

Regrouping of Claims

There is one ground of rejection, and thus, one group of claims, Group I. Group I includes claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45; however, the claims of Group I do not stand or fall together. Instead, each of the following subgroups of Group I includes claims that provide a separate basis of patentability. Appellants respectfully request removal of independent method claim 32 from Subgroup (i) and the addition of new Subgroup (v) containing independent method claim 32 as follows:

- (i) claims 1, 5-9, 13, 17, 21-24, and 28;
- (ii) claims 37, 40, and 43;
- (iii) claims 38, 41, and 44;
- (iv) claims 39, 42, and 45; and
- (v) claim 32.

Group I, Subgroup (v): Method Claim 32

Appellants respectfully request the addition of subgroup (v). Independent method claim 32 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al. (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678). Appellants respectfully submit that the rejection of this subgroup is erroneous for the reasons below, and, therefore, respectfully request reversal of this rejection.

For the reasons explained in Subgroup (i) regarding the combination of Wilson et al., Rand, and Feher failing to disclose, teach or suggest appellants' claimed sports commemorator, the combination of Wilson et al., Rand, and Feher moreover fails to disclose, teach or suggest, appellants method for displaying a sports related object and picture which include the combination of steps recited in claim 32.

In particular, the combination of Wilson et al., Rand, and Feher fail to disclose, teach or suggest the specific steps of "superimposing the transparent chamber (of the cover) over the object in the open interior", "superimposing the transparent expanse (of the cover) over and buttressing the picture on a layer in the open interior," and "securing the object and the layer in the open interior, whereby the object and the picture are displayed with the picture behind the object and the cover in the open interior so that the sports related object is visually associated with and does not substantially obscure the scene."

Based on the foregoing, appellants respectfully request reversal of the obviousness rejection of claim 32.

Reply to the Examiner's Second Answer

Appellants respond as follows to the Examiner's responses to the issues raised in appellants' first Reply Brief.

Issue No. 1

Appellants objection was that Wilson et al. (alone or in view of one skilled in the art) does not support the position that the "ticket can correspond to a picture on a layer." Merely stating that "the Examiner maintains the position that the ticket can correspond to the claimed picture on a layer" fails to address appellants' arguments

to the contrary.

First, even the Examiner correctly agrees that "Wilson does not explicitly recite the ticket is a picture."

Second, even Wilson et al. does not imply that a picture corresponds to the tickets. In particular, Wilson et al. describe the display section being sized and shaped to accommodate a single ticket or a number of tickets in a fan layout. In addition, Wilson et al. also describe that a second hollow form may be provided below the hollow form for the cap and adapted for displaying a golf ball, a baseball, or other small memento associated with the cap being displayed. Thus, Wilson et al., by listing the various other items that may be contained, teach away from providing a picture.

In addition, it is respectfully submitted that it is only with hindsight reasoning of appellants' invention that Wilson et al. is selected and the suggestion made that the ticket can correspond to the picture on a layer, and to do so is improper.

Accordingly, there is no disclosure, teaching or suggestion in Wilson et al. alone or in light of one skilled in the art that the ticket corresponds to a picture on a layer in supporting a rejection of appellants' claimed invention.

Moreover, Wilson et al. also fail to disclose, teach or suggest "a picture illustrating a scene relating to said sports related object" and "displaying said picture behind said object . . . so that said sports related object is visually associated with . . . said scene" as recited in independent claims 1, 17, and 32. Wilson et al. in combination with the other applied references also fail to teach or suggest these features as well, as set forth in appellants' Appeal Brief.

Issue No. 2

Appellants objection was with the statement that "[t]he Examiner considers the ticket and indicia thereon can correspond to a picture having indicia associated with the sports object, namely, the cap," and that specifically that Wilson et al. did not support such a position.

Merely stating that "[t]he Examiner maintains the position that the ticket can correspond to the claimed picture on a layer" and that "Wilson clearly recited that the ticket to an event is associated with the cap" fails to address appellants' arguments that Wilson et al. do not support such a position.

In particular, the Examiner fails to address appellants' arguments in Issue No. 1 that Wilson et al. do not teach or suggest the ticket corresponding to a picture. More importantly, the Examiner fails to find support in Wilson et al. wherein such a "picture" corresponds to the cap.

Again, Wilson et al. also fail to disclose, teach or suggest "a picture illustrating a scene relating to said sports related object" and "displaying said picture behind said object . . . so that said sports related object is visually associated with . . . said scene" as recited in independent claims 1, 17, and 32. Wilson et al. in combination with the other applied references also fail to teach or suggest these features as well, as set forth in Appellants brief.

Issue No. 3

Appellants again respectfully disagree with the Examiner's position that the bird is "an object used by the participant in the sport of hunting." In particular, the cabinet for preserving and displaying game in Rand includes a bird that is not an

object usable by the hunter, but instead, an animal under pursuit. In the context of hunting, a gun or a rifle for example, would be an object usable by a hunter in aiming at the bird under pursuit in hunting, and not the bird.

Appellants also disagree with the Examiner's position that "[i]t is obvious in light of Rand that a scene, such as ball field, related to the cap can be positioned behind the cap of the invention taught by Wilson to enhance the appearance of the device."

First, there is no disclosure, teaching or suggestion of a scene for "a ball field" in either Rand or Wilson et al. It is respectfully submitted that it is only with hindsight reasoning of appellants' invention that "a scene depicting a ball field" is even suggested, and attempted to be incorporated in the combination of Wilson et al. and Rand, and to do so is improper.

Second, it is not clear how exactly a scene for "a ball field" is to be incorporated into Wilson et al. Even if attempted, for the reasons set forth in appellants' first Reply Brief, such a proposed attempt would change the principle of operation of the primary reference (Wilson et al.) and/or render the reference (Wilson et al.) inoperable for its intended purpose.

Issue No. 4

With regard to Issue No. 4, appellants argument was not whether the characterization of Feher was correct or not, but instead, it was appellants position that Feher fails to disclose, teach or suggest, the features lacking in Wilson et al. and Rand.

Issue No. 5-7

With regard to claims 32 and 37-45, these claims relate to the particular image depicted in the scene. Rand neither discloses teaches or suggests the combination of the particular claimed scene, nor the particular claimed scene and a sports related object.

CONCLUSION

Appellants respectfully submit that the grounds of rejection should be reversed in all respects.

Respectfully submitted,



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